

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

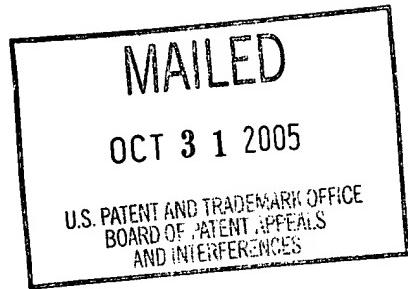
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK MADEMANN

Appeal No. 2005-2254
Application No. 09/029,688¹

ON BRIEF²



Before THOMAS, JERRY SMITH and SAADAT, Administrative Patent Judges.

SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-13, which are all of the claims pending in this application.

We reverse.

¹ Application for patent filed March 3, 1998, which is the national stage application under 35 U.S.C. § 371 of PCT Application No. PCT/DE96/01550, filed August 21, 1996.

² An oral hearing set for October 20, 2005 was waived by Appellant in a communication, received by facsimile, on October 19, 2005.

BACKGROUND

Appellant's invention is directed to sending a radio paging message to radiotelephone subscriber stations of the subscribers of a network. Instead of prompting the mobile radiotelephone subscriber to register himself with the subscriber station in the network, Appellant's invention provides for a cell identifier to be entered in a list. Thus, an item of information concerning the cell used by the subscriber may be obtained without additional signaling. An understanding of the invention can be derived from a reading of exemplary independent claim 1, which is reproduced as follows:

1. A method for sending a radio paging broadcast to radiotelephone subscriber stations of mobile radiotelephone subscribers of a cellularly constructed mobile radiotelephone network, comprising the steps of:

managing locations of the radiotelephone subscriber stations by location areas that consist respectively of at least one radio cell and that are identifiable by a location area identifier;

calling radiotelephone subscriber stations in a location area by transmission of a radio paging broadcast;

sending, in a transmission of messages respectively sent by a respective radiotelephone subscriber station, a transmitted cell identifier that identifies a current radio cell in which the respective radiotelephone subscriber station is currently located, the transmitted cell identifier being sent in addition to the location area identifier;

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storing the transmitted cell identifier in a subscriber database of the mobile radiotelephone network; and

entering the transmitted cell identifier in a list of cell identifiers comprising both the transmitted cell identifier and retained cell identifiers which were formerly transmitted cell identifiers, and sending the paging broadcast based on the list of cell identifiers, thereby retaining transmitted cell identifiers.

The Examiner relies on the following references:

| | | |
|-----------------------------------|-----------|---------------------------------------|
| Boudreau et al. (Boudreau) | 5,369,681 | Nov. 29, 1994 |
| Tiedemann, Jr. et al. (Tiedemann) | 5,588,043 | Dec. 24, 1996 |
| Kauppi | 5,953,667 | Sep. 14, 1999 (filed May 20, 1997) |

Claims 1-4, 6 and 9-13 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Kauppi and Boudreau.

Claims 5, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kauppi, Boudreau and Tiedemann.

Rather than reiterate the opposing arguments, reference is made to the briefs and answers for the respective positions of Appellant and the Examiner. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the brief have not been considered (37 CFR § 41.37(c)(1)(vii)).

OPINION

In rejecting claim 1, the Examiner relies on Kauppi for teaching the use of a cell identifier in paging the mobile unit

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and on Boudreau for disclosing a registration process that retains the previous cell identifiers (answer, page 4). In response, Appellant argues that Boudreau records the cell identifiers for statistical purposes, which are then used to generate a plurality of location areas and to derive a list based on a statistical likelihood of the mobile station being found (brief, page 6). Referring to other factors taken into account for generation of this list (brief, sentence bridging pages 6-7), Appellant further argues that the recorded cell identifiers or previously recorded cell identifiers are utilized in a list that is derived from a statistical formula (brief, page 7).

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). The Examiner must not only identify the elements in the prior art, but also show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead the individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Such evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984).

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After reviewing Boudreau, we disagree with the Examiner (answer, page 6) that the "list" of cell identifiers disclosed by the reference is the same as the claimed retaining both the transmitted and retained cell identifiers in a list and sending the paging based on the list. Boudreau discloses that the identity of the location areas from which the last response was received and where the mobile station last registered are recorded for statistical purposes which are used in optimizing the coverage area (col. 9, lines 4-10). In sending the paging message, if the last known location is not effective, Boudreau uses a group of predetermined location areas wherein the mobile station would be statistically likely to be found (col. 10, lines 2-7).

Therefore, as pointed out by Appellant (brief, page 7), the list in Boudreau includes location areas in which the mobile station is likely to be found and are derived from a statistical formula instead of the claimed list comprising the cell identifiers. As such, the Examiner's characterization of the assembled list of Boudreau as the claimed list of "retained transmitted cell identifiers" (answer, sentence bridging pages 6-7) is in error since Boudreau merely uses the previous cell identifiers in determining the likely locations which are then used for sending the paging message. The paging messages in

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Boudreau are sent based on the derived location areas, not based on the list of cell identifiers. Thus, assuming, arguendo, that it would have been obvious to combine Kauppi and Boudreau, as held by the Examiner, the combination would still fall short of teaching or suggesting the claimed entering the cell identifiers in a list and sending the paging broadcast based on the list. Accordingly, as the Examiner has failed to set forth a prima facie case of obviousness, we cannot sustain the 35 U.S.C. § 103 rejection of claims 1-4, 6 and 9-13 over Kauppi and Boudreau.

With respect to the rejection of the remaining claims, the Examiner further relies on Tiedemann, which fails to overcome the deficiencies discussed above with respect to claim 1. Therefore, the 35 U.S.C. § 103 rejection of claims 5, 7 and 8 over Kauppi, Boudreau and Tiedemann is not sustained.

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CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-13 under 35 U.S.C. § 103 is reversed.

REVERSED

[Handwritten signatures of James D. Thomas, Jerry Smith, and Mahshid D. Saadat are written over their respective typed names.]

JAMES D. THOMAS)
Administrative Patent Judge)
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Jerry Smith)
JERRY SMITH)
Administrative Patent Judge)
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)

Mahshid D. Saadat)
MAHSHID D. SAADAT)
Administrative Patent Judge)
)

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN VA 22102